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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,953	10/31/2003	David Rutter SR.	23-0223	5981

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3500 SOUTH FIRST AVENUE CIRCLE
SUITE 250
SIOUX FALLS, SD 57105

EXAMINER

HAN, JASON

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/700,953

Applicant(s)

RUTTER, DAVID

Examiner

Jason M. Han

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 5,7,8,13,14 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed October 31, 2003 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it was not submitted on a standard PTO-1449 form. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Specification

2. The disclosure is objected to because of the following informalities:
- a. Page 3, Line 2: Grammatical error: "that are coupled to vehicle that readily receive the light emitting members";
 - b. Page 6, Line 17: Grammatical error: "to viewed from";
- Appropriate correction is required.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: emergency light system "10". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the

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application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 5, 7, 8, and 14 are objected to because of the following informalities:

Grammatical error – "side wall" is a single word. Appropriate correction is required.

5. Claims 13 and 16 are objected to because of the following informalities:

Grammatical error – "thought" in line 5 of the claim. Appropriate correction is required.

6. Claims 13 and 16 are further objected to because of the following informalities:

The recitation, "said fastener apertures extending throughout the associated one of said holder members", is not accurate to the examiner. Instead, it seems that the apertures would extend throughout the mounting portion. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1-7, 9, 11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Authier (U.S. Patent 5416670).
8. With regards to Claim 1, Authier discloses a light system including:
 - A plurality of light emitting members [Figure 1: (10, 12); Figure 2: (20, 21); Figure 3: (22)]; and
 - Each of a plurality of holder members [Figure 2: (42, 44); Figure 3: (70)] selectively receiving one of the light emitting members.
9. With regards to Claim 2, Authier discloses each of the light emitting members having a perimeter wall [Figures 2-3: (23)] defining an interior space with a light emitting means therein [Column 3, Lines 14-17].
10. With regards to Claim 3, Authier discloses the light emitting means including a chemical compound being a chemiluminescent [Column 3, Lines 12-33].
11. With regards to Claim 4, Authier discloses each of the holder members having a sleeve portion [Figure 2: (42, 44); Figure 3: (72)].
12. With regards to Claim 5, Authier discloses the sleeve portion of each of the holder members including a front wall [Figure 2: (48); Figure 3: (84)], a pair of sidewalls [Figure 2: (50); Figure 3: (70)], and a rear wall [Figure 2: (26); Figure 3: (74)], whereby the front wall, sidewalls, and rear wall define a sleeve space of the sleeve portion for receiving the light emitting member.
13. With regards to Claim 6, Authier discloses the holder members including a stern holder member [Figure 3: (62)], whereby the front wall of the sleeve portion of the stern

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holder member includes a stern aperture [Figure 3: (72)] extending through the front wall of the sleeve portion.

14. With regards to Claim 7, Authier discloses the holder members including a bow holder member [Figure 2: (28)], whereby the sleeve portion of the bow holder member includes a bow aperture [Figure 2: (42, 44)] such that the bow aperture extends through the front wall and a portion of each of the sidewalls of the sleeve portion of the bow holder members.

15. With regards to Claim 9, Authier discloses each of the holder members including a pair of end portions [Figure 2: (38, 40); Figure 3: (74, 84)] being coupled to the sleeve portion of the associated holder member such that one of the end portions is positioned opposite the other one of the end portions, and whereby each of the end portions includes a bore [Figure 2: (34, 36); Figure 3: (72)] such that the bore of each of the end portions is in communication with the sleeve portion of the associated holder member.

16. With regards to Claim 11, Authier discloses each of the holder members including a mounting portion [Figure 2: (28); Figure 3: (62)].

17. With regards to Claim 13, Authier discloses the mounting portion of each of the holder members including a plurality of fastener apertures [Figure 2: (32); Figure 3: (68)], whereby the fastener apertures extend throughout the mounting portion of the associated one of the holding members.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Authier (U.S. Patent 5416670) as applied to Claim 5 above.

Authier discloses the claimed invention as cited above, except for the holder members including a pair of side holder members with a side aperture that extends through the front wall and a portion of one of the sidewalls of the sleeve portion of the associated side holder member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the side holder members, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In this case, duplicating the holder members to be positioned on the side of a vehicle would produce even greater illumination and warning.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the holder members at different locations and mountings on a vehicle, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70. In this case, it is obvious that the applicant is merely claiming different mounting configurations, whereby all the holders are functionally equivalent in emitting a light.

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19. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Authier (U.S. Patent 5416670) as applied to Claim 9 above, and further in view of Slutsky (U.S. Patent 2125403).

Authier discloses the claimed invention above, but does not specifically teach all holder members having a bore at each end including a first portion of greater diameter than a second portion, such that a lip is formed between the first and second portions.

Slutsky teaches a bore member [Figure 4: (22)] for insertion of a light member [Figure 4: (13)] including a first portion of greater diameter [Figure 3: (16)] than a second portion [Figure 3: (15)], such that a lip is formed between the first and second portions [Figures 3-4: (18)].

It would have been obvious to modify the light system of Authier to incorporate the bore of Slutsky in order to provide firm hold of the light emitting members. Such annular stops are commonly known within the art, whereby it also would have been an obvious matter of design choice to change the diameters of different portions of the bore, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

20. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Authier (U.S. Patent 5416670) as applied to Claim 11 above, and further in view of Moscarillo (U.S. Patent 4405973).

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Authier discloses the claimed invention as cited above, but does not specifically teach the mounting portions of each of the holder members including an adhesive material.

Moscarillo teaches emergency light sources, wherein "an adhesive ring is provided for attaching the light source to the object to be illuminated [Abstract]."

It would have been obvious to modify the light system of Authier to incorporate the adhesive material of Moscarillo in order to provide a strong hold for the device onto an object [e.g. vehicle]. In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an adhesive material, since it has been held to be within general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

21. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Authier (U.S. Patent 5416670) in view of Slutsky (U.S. Patent 2125403).

With regards to Claim 14, Authier discloses a lighting system including:

- A plurality of light emitting members [Figure 1: (10, 12); Figure 2: (20, 21); Figure 3: (22)];
- Each of a plurality of holder members [Figure 2: (42, 44); Figure 3: (70)] selectively receiving one of the light emitting members;
- Each of the light emitting members having a perimeter wall [Figures 2-3: (23)] defining an interior space with a light emitting means therein [Column 3, Lines 14-17];

- Said light emitting means including a chemical compound being a chemiluminescent [Column 3, Lines 12-33];
- Each of the holder members having a sleeve portion [Figure 2: (42, 44); Figure 3: (72)];
- The sleeve portion of each of the holder members including a front wall [Figure 2: (48); Figure 3: (84)], a pair of sidewalls [Figure 2: (50); Figure 3: (70)], and a rear wall [Figure 2: (26); Figure 3: (74)], whereby the front wall, sidewalls, and rear wall define a sleeve space of the sleeve portion for receiving the light emitting member;
- The holder members including a stern holder member [Figure 3: (62)], whereby the front wall of the sleeve portion of the stern holder member includes a stern aperture [Figure 3: (72)] extending through the front wall of the sleeve portion;
- The holder members including a bow holder member [Figure 2: (28)], whereby the sleeve portion of the bow holder member includes a bow aperture [Figure 2: (42, 44)] such that the bow aperture extends through the front wall and a portion of each of the sidewalls of the sleeve portion of the bow holder members;
- Each of the holder members including a pair of end portions [Figure 2: (38, 40); Figure 3: (74, 84)] being coupled to the sleeve portion of the associated holder member such that one of the end portions is positioned opposite the other one of the end portions, and whereby each of the end portions includes

a bore [Figure 2: (34, 36); Figure 3: (72)] such that the bore of each of the end portions is in communication with the sleeve portion of the associated holder member; and

- Each of the holder members including a mounting portion [Figure 2: (28); Figure 3: (62)].

Authier does not specifically teach the holder members including a pair of side holder members with a side aperture that extends through the front wall and a portion of one of the sidewalls of the sleeve portion of the associated side holder member.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the side holder members, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In this case, duplicating the holder members to be positioned on the side of a vehicle would produce even greater illumination and warning. In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the holder members at different locations and mountings on a vehicle, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70. In this case, it is obvious that the applicant is merely claiming different mounting configurations, whereby all the holders are functionally equivalent in emitting a light.

Authier also does not specifically teach all holder members having a bore at each end including a first portion of greater diameter than a second portion, such that a lip is formed between the first and second portions.

Slutsky teaches a bore member [Figure 4: (22)] for insertion of a light member [Figure 4: (13)] including a first portion of greater diameter [Figure 3: (16)] than a second portion [Figure 3: (15)], such that a lip is formed between the first and second portions [Figures 3-4: (18)].

It would have been obvious to modify the light system of Authier to incorporate the bore of Slutsky in order to provide firm hold of the light emitting members. Such annular stops are commonly known within the art, whereby it also would have been an obvious matter of design choice to change the diameters of different portions of the bore, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

22. With regards to Claim 16, Authier in view of Slutsky discloses the claimed invention as cited above. In addition, Authier discloses the mounting portion of each of the holder members including a plurality of fastener apertures [Figure 2: (32); Figure 3: (68)], whereby the fastener apertures extend throughout the mounting portion of the associated one of the holding members.

23. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Authier (U.S. Patent 5416670) in view of Slutsky (U.S. Patent 2125403) as applied to Claim 14 above, and further in view of Moscarillo (U.S. Patent 4405973).

Authier in view of Slutsky discloses the claimed invention as cited above, but does not specifically teach the mounting portions of each of the holder members including an adhesive material.

Moscarillo teaches emergency light sources, wherein "an adhesive ring is provided for attaching the light source to the object to be illuminated [Abstract]."

It would have been obvious to modify the light system of Authier with the bore of Slutsky to further incorporate the adhesive material of Moscarillo in order to provide a strong hold for the device onto an object [e.g. vehicle]. In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an adhesive material, since it has been held to be within general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art pertinent to the current application, but are not considered exhaustive:

US Patent 3500033 to Cole, Jr. et al;

US Patent 3940604 to Rauhut;

US Patent 4814949 to Elliott;

US Patent 5043851 to Kaplan;

US Patent 5446629 to Steiger et al;

US Patent 3539794 to Kennerly et al;

US Patent 4635166 to Cameron;

US Patent 4972300 to Beisswanger et al;

US Patent 5381312 to Authier;

US Patent 5797669 to Fujita;

US Patent 6033080 to Haswegawa et al;

US Patent 6231217 to Krippelz, Sr.;

US Patent 6336729 to Pavelle et al;


US Patent 6550929 to Dumas.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Han whose telephone number is (571) 272-2207. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMH (2/22/2005)



JOHN ANTHONY WARD
PRIMARY EXAMINER